

U.S. Appln. No. 10/675,890
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REMARKS

Claims 1-4 stand provisionally rejected under the "judicially created doctrine of obviousness type double patenting" as being unpatentable over claims 1-3 and claims 1-19 of US 6,808,928 and US 6,844,198 respectively. Applicants note that the cited patents are commonly owned by the assignee of the present application and has at all times been so owned. Consequently, the rejection may be cured by the submission of a Terminal Disclaimer which applicants have attached hereto. Applicants respectfully request the rejection promulgated under the judicially created doctrine of obviousness type double patenting be withdrawn.

Claim 4 stands rejected under 35 U.S.C. §102(e) as being anticipated by Willson, US 6,063,633. Applicants traverse the rejection and assert that each and every element of applicants' claimed invention as amended is not taught in the cited reference.

The office action states that Willson, at claims 42+, teaches a method for determining the catalytic activity at different temperatures and measuring the relative temperatures. Reviewing claims 42-52, Claim 42 teaches that the apparatus has a means for contacting the catalyst with a reactant at reaction conditions (Col. 14 lines 20-22) and claims 45 adds the additional element of a means for providing a different temperature in different catalyst formulations (Col. 14 lines 37-39). Claims 42+ of Willson fail to teach contacting the catalysts with an inert fluid while measuring the change in temperature of the respective catalysts using a detector and while concurrently ramping the temperature at a controlled ramp rate using temperature controllers as required in step (b) of applicants' claim 4. Nowhere does Willson teach ramping the temperature at a controlled ramp rate while measuring changes in temperature of the catalysts. At Col 11. lines 13-17, Willson teaches that the stabilization step can be carried out with a temperature gradient, however, the stabilization step is not measured by any technique to determine the activity of the catalysts. The stabilization step is optional and is for the purpose of stabilizing the catalyst ingredients in the cells spots or pellets (col. 1 lines 49-51).

In light of the Willson reference failing to teach a claimed element of applicants' invention, specifically, Claim 4 step(b), the anticipation rejection as to Claim 4

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promulgated under 35 U.S.C. 102 must fail. Applicants respectfully ask that the rejection be withdrawn.

Claims 1-3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Willson US 6,063,633. Applicants traverse the rejection and assert that Willson fails to teach, suggest, or provide motivation for applicants' invention as claimed and that a *prima facie* case of obviousness has not been established. Absent applicants' own disclosure, there is nothing in the cited references that would teach or suggest applicants' invention as claimed.

A fundamental difference between Willson and Claims 1-3 of the present invention is that Willson is a method of simultaneously testing a plurality of catalyst formulations to determine comparative catalyst activity while applicants have claimed a method of quantifying the amount of adsorbate adsorbed on a solid. Since the goal of the reference and the goal of the present invention are so diverse, it follows that the steps to achieve that goal are similarly very different. For example and as discussed above, Willson fails to teach or suggest applicants' claimed steps of ramping the temperature of the solid(s) while measuring the change in temperature of the solids. Furthermore, Willson fails to teach measuring the change in the temperature of the solids while contacting with an inert fluid as required in applicants claim 1 (c). Instead, Willson teaches detecting catalytic activity while contacting the catalysts of Willson with a reactant and not with an inert fluid. There is no teaching in Willson to measure the change in temperature of the solids during contacting with an inert fluid.

As to applicants' claimed relationships to determine the amount of adsorbate adsorbed, Willson fails to teach or suggest any method of measuring the amount of adsorbate adsorbed. The official office action states that the chosen empirical relationship between the observed or measured temperature and amount of catalyst would have been within the skill of the art and have the well known and predictable results of making a standard reference curve. However, the Willson invention is a method of determining comparative catalytic activity. Willson is not a method of quantifying the amount of adsorbate adsorbed on a solid. The relationship in applicants' claim 1 is not between the observed or measured temperature and amount of catalyst as suggested by

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the office action and would not have the well known and predictable results of making a standard reference curve.

With the Willson reference failing to teach, suggest, or hint at several claimed features of applicants' invention, a *prima facie* case of obviousness has not been established and applicants respectfully request that the rejection of Claim 1-3 promulgated under 35 USC 103(a) be withdrawn.

Accordingly, in view of the above amendments and remarks, this application is now believed to be in a condition for an allowance of all remaining claims and such action is respectfully requested.

Respectfully submitted,



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